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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,899,686	07/05/2001	Chester A. Bacon JR.	56345US002	3477

7590 11/27/2002

Attention: Carolyn A. Fischer
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,686

Applicant(s)

BACON, CHESTER A.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 28-31, 33-36, 38-41, 43-46, 48-51 and 53-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-27, 32, 37, 42, 47 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

a) ☐ The translation of the foreign language provision(s) has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Information Disclosures (IDS) filed on _____.
- 2) ☐ Information Disclosures (IDS) filed on _____.
- 3) ☐ Information Disclosures (IDS) filed on _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, 28-31, 33-36, 38-41, 43-46, and 48-51, drawn to an article with a defined composition, classified in class 428, subclass 423.1.
 - II. Claims 23-27, 32, 37, 42, 47, and 52, drawn to an article with a layer of defined solubility, classified in class 564, subclass 505.
 - III. Claims 53-65, drawn to a composition, classified in class 525, subclass 50.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II represent separate and patentably distinct inventions. None of the parameters of group I appear in group II, with the exception of the claim that the layer be printable. Therefore, these two groups encompass different structures and different inventions, each capable of holding their own patent.

3. Inventions II and III and inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as

combinations (MPEP § 606.03(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the

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combination of groups I and II do not require the exact hard components that the subcombination utilizes. The subcombination has separate utility such as a for forming a free-standing film.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. Carolyn Fischer on November 18, 2002 a provisional election was made with traverse to prosecute the invention of group II, claims 23-27, 32, 37, 42, 47, and 52. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-22, 28-31, 33-36, 38-41, 43-46, 48-51, and 53-65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in any country before the date of the invention by the inventor or by another person;

Malik et al. (2010) injected under 35 °C S.C. 102(b) as being anticipated by Malik et al.

Malik et al. discloses a fluorinated polyurethane urea composition (column 2, line 63) that is stain resistant (column 1, line 21). The compositions are elastomeric (flexible) and are soluble in acetone but insoluble in toluene (example 19), meeting the requirements of claims 23 and 24. The composition may be transparent (column 13, line 48), or present as a paint (column 14, line 27) which inherently indicates the presence of a substrate and meets these aspects of claims 26 and 32.

Regarding the printability of the composition in Malik et al., the reference indicates that the composition is useful in clothing or as a coating on clothing (column 1, line 53). Since most clothing is dyed or has logos or designs printed on it, the composition is assumed to be printable, even though that exact phrase is not used. Further, the use of the composition as a coating on clothing indicates a laminate structure where the fabric is dyed or colored, meeting that restriction of claim 47.

Finally, the thickness of the composition when it is used as a coating is not expressly disclosed by Malik et al., but it is evident that one could manipulate the thickness of a coating having the composition disclosed by Malik et al. to the range indicated in claim 27 and still be within the scope of Malik et al. Malik et al. therefore meets claim 27.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. in view of each of Seltmann et al. and Roitman et al.

Malik et al. discloses the invention of claim 23 as shown above, but does not include the enhanced surface slip properties that the applicant claims in claim 25.

Seltmann et al. and Roitman et al. disclose this aspect of the invention.

Seltmann et al. discloses that surface slip additives (column 2, lines 46-48) are added to coating compositions in order to improve their surface slip properties. Similarly, Roitman et al. discloses that the surface slip properties of a composition may be improved through the addition of a reactive silicone (column 6, line 30).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the surface slip additives of Seltmann et al. or Roitman et al. in the composition in Malik et al. The motivation for doing so would be to improve the surface slip properties of the composition. Therefore it would have been obvious to combine Seltmann et al. or Roitman et al. with Malik et al. to obtain the invention as specified in claim 25.

10. Claims 32, 37, 42, 47, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view of Malik et al.

Fleming discloses a coating composition and meets this aspect of claims 32, 37, 42, 47, and 52. Fleming does not, however, disclose a coating of the

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composition that the applicant claims in claim 23. Malik et al. discloses this coating and teaches that the coating composition is useful for coating substrates to give them protection from environmental degradation (column 14, line 8). When the coating in Malik et al. is coated on the retroreflective sheeting in Fleming, the polyurethane layer between the coating and the substrate is by definition a bonding layer that connects the two layers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to coat the retroreflective sheet in Fleming with the coating in Malik et al. The motivation for doing so would be to provide protection from environmental degradation to the retroreflective sheet. Therefore it would have been obvious to combine Malik et al. with Fleming to obtain the invention as specified in claims 32, 37, 42, 47, and 52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 370-6000 for after hours communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
November 21, 2002



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700